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09/658,770	09/11/2000	Frank J. McConnell	SACO115537	4422

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EXAMINER

PASS, NATALIE

ART UNIT PAPER NUMBER

3626

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,770

Applicant(s)

MCCONNELL ET AL.

Examiner

Natalie A. Pass

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 2 June 2003. Claims 1, 3-6, 8, 10, 14, and 19 have been amended. Claims 2 and 9 have been cancelled. Claims 1, 3-8, 10-19 remain pending.

Specification

2. The objection to the disclosure is hereby withdrawn due to the amendment filed 2 June 2003.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitcham, U.S. Patent Number 5, 537, 315 for substantially the same reasons given in the previous Office Action (paper number 5). Further reasons appear hereinbelow.

(A) Claim 1 has been amended to recite the limitation of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation and in

Art Unit: 3626

response to said request, re-intermediating an insurance agent and issuing said insurance policy" in lines 13-16.

As per these new limitations, Mitcham teaches a method for providing an insurance policy via a distributed computing network further comprising receiving a request to purchase said insurance policy according to said bindable insurance premium quotation and in response to said request, re-intermediating an insurance agent and issuing said insurance policy (Mitcham; see at least Figure 13, lines 32-34, Figure 14A, column 1, lines 64-67, column 2, lines 2-15, column 4, lines 16-17, 22-25, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column 10, line 8).

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 5, section 4, pages 2-3), and incorporated herein.

(B) Claim 3 has been amended to change its dependency from claim 2 to claim 1. While this change renders the language of the claims smoother and more consistent, it otherwise affects neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section 4, pages 2-3), and incorporated herein.

(C) Claim 19 has been amended to reflect the cancellation of dependent claim 2. While this change renders the language of the claims smoother and more consistent, it otherwise

Art Unit: 3626

affects neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section 4, page 4), and incorporated herein.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-8, 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent Number 5, 537, 315 in view of CNA Customer Services State Sales Offices website, hereinafter known as CNA, URL:

<http://web.archive.org/web/20000311214508/www.cna.com/group/custserv/gr_state.html>, and

further in view of MostChoice Advisor website, hereinafter known as MostChoice, URL:

<[http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor_Center/](http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor_Center/Why/G_Adv_Why_Overview.cfm)

[Why/G_Adv_Why_Overview.cfm](http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor_Center/Why/G_Adv_Why_Overview.cfm)> for substantially the same reasons given in the previous

Office Action (paper number 5). Further reasons appear hereinbelow.

(A) Claims 4-6 have been amended to change their dependencies from claim 2 to claim 1. While this change renders the language of the claims smoother and more consistent, it otherwise affects neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section 6, pages 4-7), and incorporated herein.

(B) Claim 7 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 5, section 6, pages 4-7), and incorporated herein.

(D) Claim 8 has been amended to recite the limitation of "receive a request to purchase said insurance policy according to said bindable insurance premium quotation; re-intermediate an insurance agent and issue said insurance policy" in lines 14-17.

As per these new limitations, Mitcham teaches a method for providing an insurance policy via a distributed computing network further comprising receiving a request to purchase said insurance policy according to said bindable insurance premium quotation and in response to said request, re-intermediating an insurance agent and issuing said insurance policy (Mitcham; see at least Figure 13, lines 32-34, Figure 14A, column 1, lines 64-67, column 2, lines 2-15, column 4, lines 16-17, 22-25, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column 10, line 8).

Art Unit: 3626

The remainder of claim 8 is rejected for the same reasons given in the prior Office Action (paper number 5, section 6, pages 7-8), and incorporated herein.

(E) Claim 10 has been amended to change its dependency from claim 9 to claim 8. While this change renders the language of the claims smoother and more consistent, it otherwise affects neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section 6, pages 8-9), and incorporated herein.

(F) Claims 11-13 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5, section 6, pages 8-9), and incorporated herein.

(G) Claim 14 has been amended to change its dependency from claim 9 to claim 8. While this change renders the language of the claims smoother and more consistent, it otherwise affects neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section 6, page 10), and incorporated herein.

(H) Claims 15-18 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5, section 6, pages 10-11), and incorporated herein.

(I) Claim 19 has been amended to reflect the cancellation of dependent claim 2. While this change renders the language of the claims smoother and more consistent, it otherwise affects neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section 6, page 11), and incorporated herein.

Response to Arguments

7. Applicant's arguments filed 2 June 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 2 June 2003.

(A) At pages 10-12 of the 2 June 2003 response, Applicant argues that the newly added features in the 2 June 2003 amendment are not taught or suggested by the applied reference and that a *prima facie* case of anticipation has not been established.

In response, all of the limitations which Applicant disputes are missing in the applied reference, including the features newly added in the 2 June 2003 amendment, have been fully

Art Unit: 3626

addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of Mitcham, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 102 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 5), and incorporated herein. In particular, Examiner notes that Mitcham teaches re-intermediating the insurance agent following the receipt of a request to purchase an insurance policy. Note, for example, that Mitcham teaches a system where, in one embodiment, "[t]he options may include completing an application, having a representative of the company contact the user, printing a quote of the selected level of coverage, or exiting the program" (Mitcham; column 6, lines 20-24). Further, Mitcham teaches that it is known in the insurance industry for a representative or agent of an insurance company to create an insurance agreement or policy based on information obtained from a prospective insured and that an insurance rate is calculated based on the information the prospective insured provides, in addition to the level of coverage the individual desires (Mitcham; column 1, lines 64 to column 2, line 2) and as well, Mitcham advises, in Figure 13, that "no sales call will be made without your request. To purchase your policy, please contact [...insurance agency or agent...] at [...recited phone number...]", thus teaching re-intermediating the agent upon receiving a request to purchase a policy. The Examiner therefore has correctly established a *prima facie* case of anticipation.

(B) At pages 12-15 of the 2 June 2003 response, Applicant apparently argues that a *prima facie* case of obviousness has not been established.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 5) have been expressly articulated. Note, for example, the motivations explicitly stated at lines 6-7 of page 6 of the previous Office Action (i.e., "the motivation of assisting and enabling customers to ... ") and at lines 8-12 of page 7 of the prior Office Action (i.e., "the motivation of educating and empowering ...").

Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Simply stated, what distinctions, if any, are there between Applicant's recited terminal, data storage, and programmed processor and the corresponding elements of the Kudo and Tenma references? Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52

CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

(C) At page 14-15 of the 2 June 2003 response, Applicant argues that the reference cited from an archived website is not an enabling reference. The MostChoice website, consisting of a plethora of linked web pages, 12 of which are used as references, was actively maintained during the period cited, and recites the claimed elements as analyzed and discussed in the prior Office Action (paper number 5) and in the current Office Action. As is well known in the art, archived web pages are frequently not maintained to the present day. Many archived websites are, in fact, actively disabled by site owners using software known as robots. Nevertheless, the discovery by Applicant of one web page listed as "Under Construction" today neither proves nor disproves the enablement of these web pages at the time the claimed invention was made. Furthermore, it has been established that "[e]ven if a reference discloses an inoperative device, it is prior art for all that it teaches." *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991)

(D) At pages 12-17 of the 2 June 2003 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

Art Unit: 3626

USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mitcham's method and system for providing an insurance policy via a distributed computing network (Mitcham; column 3, line 62 to column 4, line 3) in which the insurance agent or representative is re-intermediated following the receipt of a request to purchase an insurance policy (Mitcham; Figure 13, column 1, lines 64 to column 2, line 2, column 6, lines 20-24) to include the CNA reference, which includes providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual, receiving the selection of a selected agent from the list of available insurance agents and transmitting information regarding said individual and said insurance policy to said selected insurance agent, (CNA; pages 1-10) with the motivation of assisting and

Art Unit: 3626

enabling customers to find the and utilize the information they need when purchasing insurance (CNA; pages 13, 16), and to modify the collective teachings of Mitcham and CNA to include the MostChoice reference, which includes assigning said selected insurance agent to said insurance policy and remitting a commission to said selected insurance agent wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer (MostChoice; pages 1-12) with the motivation of educating and empowering potential customers to purchase insurance by connecting them with certified local advisors who are knowledgeable experts, don't let customers "fall through the cracks," are always available to answer questions, and can help customers get what they want without any pressure, and to entice the best agents (MostChoice; pages 1, 6, 8, 10).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5

Art Unit: 3626

USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Art Unit: 3626

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Conclusion

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

Art Unit: 3626

or faxed to:

(703) 305-7687.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

NP

Natalie A. Pass

July 29, 2003

Joseph Thomas
JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
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